Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 555255-012729	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _April 17, 2009_ Signature _Debra Pejeau_ Typed or printed name Debra Pejeau	Application Number 10/786,961	Filed 02/25/2004
	First Named Inventor David R. Clark	
	Art Unit 2617	Examiner Addy, Anthony S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number _47,919_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Joseph M. Sauer/
_____
Signature

Joseph M. Sauer
_____
Typed or printed name

216-586-7506
_____
Telephone number

04/17/2009
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Attorney Docket No. 555255-012729

Group Art Unit:	2617	)
		)
Examiner:	Anthony Addy	)
		)
Inventor:	David R. Clark, et al.	)
		) **PRE-APPEAL BRIEF**
Serial No.:	10/786,961	) **REQUEST FOR REVIEW**
		)
Filed:	Feb. 25, 2004	)
		)
For:	Mobile Device Programming	)
	System and Method	)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Claims 1, 4-6, 16, 48-50, and 53 stand finally rejected under 35 U.S.C. § 103(a). The

rejection of the pending claims is now appealed. Applicant hereby requests review of the final

rejection prior to filing an appeal brief because the rejection fails to prove a *prima facie* case of

unpatentability and there is clear error in the rejection of these claims. Any fees due should be

charged to Jones Day Deposit Account No. 501432, ref: 555255-012729.

The Rejection of Independent Claim 1 Is Clearly Erroneous because the Cited References Fail to Disclose Every Element of the Claim

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S.

Publication No. 2004/0192282 (Vasudevan) in view of U.S. Patent No. 5,008,814 (Mathur) and

further in view of U.S. Publication No. 2004/0243993 (Okonnen). With regard to the

combination of Vasudevan and Mathur, the office action admits that the combination of

references fails to teach numerous claim limitations:

> [The combination of Vasudevan and Mathur] fails to explicitly teach determining whether an update resource is stored in the mobile device memory during an initialization of the mobile device; upon determining that the update resource is stored in the mobile device memory during an initialization of the mobile device, prompting a mobile device user to select one of the baseline mobile device configuration or updated mobile device configuration; and accepting the updated mobile device configuration or reverting to the baseline mobile device configuration based on the user selection. (Office Action, p. 5.)

The office action cites to Okonnen as allegedly teaching the missing subject matter from both Vasudevan and Mathur. Specifically, the office action cites paragraphs 55 and 57-59 of Okonnen. Okonnen, though, does not disclose the subject matter that is absent from Vasudevan and Mathur. As noted above, claim 1 recites "prompting a mobile device user to select one of the baseline mobile device configuration or updated mobile device configuration and accepting the updated mobile device configuration or reverting to the baseline mobile device configuration based on the user selection." By contrast, the cited passages from Okonnen make clear that there is no "prompt" to a mobile device user to select one of a baseline configuration or an updated configuration, nor is an updated configuration "accepted" or a reversion to a baseline configuration made based on a choice by the mobile device user. Thus, the final two steps of claim 1 are clearly missing from Okonnen.

The cited passages from Okonnen teach that a user is presented with "[a] list of provisioned update agents," and if the user selects an update agent, "the UA loader 127 may invoke the selected provisioned update agent and transfer control to the selected update agent." (Okonnen, ¶ 58.) Okonnen also teaches, though, that a particular update agent is used to update a particular aspect of the mobile handset, a fact that the office action acknowledges when it states, "based on the selection by the end-user, an update to a particular firmware, software, hardware configuration, etc., in the mobile handset is performed." (Office Action, p. 6.) This is

not the same as the "prompting" and "accepting" steps recited in claim 1. As recited elsewhere in claim 1, "the baseline mobile device configuration is maintained within the mobile device memory for a period of time sufficient to allow the updated mobile device configuration to be tested." That is, both the baseline configuration and the updated configuration are maintained on the mobile device, and the user is then prompted to select one of the configurations, either accepting the updated configuration or reverting to the baseline configuration. Merely teaching that a user may selectively update one of several aspects of a mobile handset in no way teaches the subject matter admittedly missing from the Vasudevan and Mathur references. For at least these reasons, Applicant submits that the cited references fail to teach every element of claim 1. Thus, claim 1 is allowable and should proceed to issuance.

Independent claims 48 and 53 recite subject matter analogous to the subject matter of claim 1 against which Okonnen was cited, and the office action relies on Okonnen in rejecting these claims. Therefore, claims 48 and 53 are allowable for at least the same reasons as claim 1, and they too should proceed to issuance. Further, each of the dependent claims in the instant application ultimately depends from an independent claim that is allowable, so the dependent claims are also allowable for at least the same reasons as the independent claims. The Panel is therefore respectfully requested to withdraw the rejection of claims 1, 4-6, 16, 48-50, and 53 and pass this case to issue.

Respectfully submitted,
JONES DAY

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